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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,275	03/18/2004	Pamela K. Lowenthal	36655-95604	5378
7590	09/01/2005		EXAMINER	
Cynthia L. Smith Barnes & Thornburg P.O. Box 2786 Chicago, IL 60690-2786			PRONE, JASON D	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,275

Applicant(s)

LOWENTHAL, PAMELA K.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 14-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species A: Figures 1-8
- Species B: Figure 5-9

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Cynthia Smith on 19 July 2005 a provisional election was made without traverse to prosecute the invention of species A, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: On page 7 line 19, item "48". On page 8 last line, item "72". On page 9 line 1, item "74". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top

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margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "50" has been used to designate both non-circular cutting surface and a first die. Numerous occurrences of item "50" appear throughout the specification and need appropriate correction. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because In Figure 4, since one of the handles does not appear in a hidden/ghost form, the apparatus appears to have 2 handles. Since Figure 4 is representing the punching in the compressed stage, the top handle should be in a ghost image format. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures

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appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rall (5,611,254).

In regards to claim 1, Rall discloses the same invention including a hole punch (10) a base plate having an engaging surface for substantially horizontal engagement with the work piece (30), a guide bracket having a first portion and a second portion

extending from the first portion (34), the first portion of the guide bracket fixedly mounted to a first portion of the engaging surface (Fig. 4), the second portion of the guide bracket extending adjacent to and spaced apart from a second portion of the engaging surface (Fig. 4) to define a horizontal slot having a wall surface extending between the engaging surface and the second portion of the guide bracket (36), the second portion of the guide bracket includes a first and second bore extending through (38), and the first and second bores are perpendicular to the engaging surface (Fig. 5). Rall further disclose, in regards to claim 1, a lever arm pivotally mounted to the guide bracket (40), the lever arm having a first and second bearing surface (44), a first/second punch disposed in the first/second bore (28), the first/second punch having a top end surface and an opposing bottom end non-circular cutting surface (Fig. 11A), the top end surface of the first/second punch engagedly coupled to the first/second bearing surface (Fig. 5), and the first/second punch being operable to perforate the work piece in response to movement of the lever arm towards the base plate (Fig. 5).

In regards to claims 2-5, Rall discloses each of the bottom-end non-circular cutting surfaces of the first and second punches comprise a rectangular cutting surface (Figs. 11 and 11A), an elongated cutting surface (Fig. 11), a D-shaped cutting surface (Fig. 6), and a modified D-shaped cutting surface (Fig. 7).

In regards to claim 6, Rall discloses the engaging surface includes a first and second die (32) and the first/second defining a first/second die aperture configured to receive the bottom end non-circular cutting surface of the first/second punch.

In regards to claim 7, Rall discloses the first bearing surface extending outwardly from a first/second planar sidewall (Fig. 5 sidewall of the lever shown and the opposite sidewall of the lever not shown) of the lever arm to engaging the top end surface of the first/second punch (44).

In regards to claim 8, Rall discloses a first/second upstanding flange mounted to the top of the first portion of the guide bracket proximate to the first/second planar sidewall of the lever arm (Fig. 5 hidden lines above item 42 and the corresponding flange on the other side), the first and second upstanding flanges having aligned apertures (42).

In regards to claim 9, Rall discloses a pivot pin fixedly mounted between the first and second planar sidewalls (42) the pivot pin extending through the apertures for relative movement of the lever arm about the pivot pin (42).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rall in view of Yerkes (2,524,582). Rod discloses the invention but fails to disclose, in regards to claim 10, a first/second resilient member disposed around the first/second punch, a first end of the first/second resilient member coupled to a first/second lip radially disposed in the first/second bore and a second end of the first/second resilient

member coupled to a radially extending flange disposed proximate to the top end surface of the first/second punch, and the first/second resilient biases the first/second punch away from the base plate. In regards to claim 11, Rall fails to disclose an adjustable guide adapted to position the work piece. In regards to claim 12, Rall fails to disclose a first/second rod assembly adapted to reciprocally move within at least one aperture formed in a first/second side of the base plate, the first/second assembly having at least one reciprocally moveable rod and an angled bracket perpendicularly mounted to a first end of the at least one rod. In regards to claim 13, Rall fails to disclose the at least one rod of the first rod assembly is adapted to interlink with the at least one rod of the second rod assembly, and the linear reciprocal movement of the first rod assembly causes equal linear reciprocal movement of the second rod assembly.

In regards to claim 10, Yerkes teaches a first/second resilient member disposed around the first/second punch (35), a first end of the first/second resilient member coupled to a first/second lip radially disposed in the first/second bore (32) and a second end of the first/second resilient member coupled to a radially extending flange disposed proximate to the top end surface of the first/second punch (34), and the first/second resilient biases the first/second punch away from the base plate (35).

In regards to claim 11, Yerkes teaches an adjustable guide adapted to position the work piece (45).

In regards to claim 12, Yerkes teaches a first/second rod assembly (45) adapted to reciprocally move within at least one aperture formed in a first/second side of the

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base plate (50), the first/second assembly having at least one reciprocally moveable rod (45) and an angled bracket perpendicularly mounted to a first end of the at least one rod (47).

In regards to claim 13, Yerkes teaches the at least one rod of the first rod assembly is adapted to interlink with the at least one rod of the second rod assembly (54), and the linear reciprocal movement of the first rod assembly causes equal linear reciprocal movement of the second rod assembly (54).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Rall with a resilient member and an adjustable guide, as taught by Yerkes, to allow the handle to move to the inoperative state after each punch is completed and to better align the work piece with the punches.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yerkes ('094), Marano, Brook, Steiner et al., Goertz et al., Davi, Blair, Lee, Davies, Racamier, Lin, and Bodum.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 571-272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP
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